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In re Application of :
Michael R. Duff et al :
Serial No.: 10/645,844 : PETITION DECISION
Filed: August 22, 2003 :
Attorney Docket No.: 31735/70009 :

This is in response to the petition under 37 CFR 1.144, filed July 1, 2006, requesting withdrawal of an improper restriction requirement.

BACKGROUND

A review of the file history shows that this application was filed under 35 U.S.C. 111 on August 22, 2003, and contained, as amended, claims 41-50. In a first Office action, mailed April 16, 2004, the examiner required restriction between the inventions claimed, as follows:

Group I – Claims 41 and 47-50, drawn to a method of decreasing drowsiness using a towelette impregnated with an organic substance;

Group II – Claims 42 and 44-46, drawn to a method of decreasing drowsiness using a towelette impregnated with ammonia;

Group III – Claim 43, drawn to a method of decreasing drowsiness using a towelette impregnated with an organic substance and ammonia.

The examiner reasoned that the methods were unrelated due to different operation, function and/or effect and are disclosed as capable of separate use..

Applicants replied on April 28, 2004, electing Group III with traverse on the basis that the examiner reasoning does not provide different modes of operation, effect or function.

The examiner mailed a new Office action to applicants on May 27, 2004, acknowledging the election of Group III and the traversal, but maintaining the requirement, and making it Final on the basis that although the claims seem to be overlapping the search would not be coextensive. The examiner then rejected claim 43 under 35 U.S.C. 112, first paragraph, as lacking written description and under 35 U.S.C. 103(a) as unpatentable over Furman in view of the Merck Index.

This petition was filed on July 1, 2004, traversing the restriction requirement as being in error. A response to the Office action was filed concurrently. The existence of the petition was not brought to the attention of the deciding official until recently.

DISCUSSION

Applicants' petition is directed to the examiner's reasoning as to why restriction is required in view of the fact that all claims recite an identical set of method steps and differ only in the substances impregnated onto the towelette. The Group I impregnant is an organic substance which releases vapors to stimulate the olfactory nerves. The Group II impregnant is a combination of an organic substance and ammonia to stimulate both skin and olfactory nerves. The Group III impregnant is ammonia and specific organic substances which are known to emit vapors which stimulate the olfactory nerves as well as skin nerves. Thus contrary to the examiner's assertion, Group II is not limited to just ammonia. Thus the claims of Groups II and III are of similar scope and are hereby rejoined. The claims of Group I specify only the use of an organic substance, but allow due to the "comprising" language of the claim the addition of other stimulating substances, such as ammonia. In view of this and the fact that the active method steps are essentially identical for each Group, the restriction requirement is withdrawn.

DECISION

The petition is **GRANTED**.

The application will be forwarded to the examiner for consideration of applicants' reply filed July 1, 2004, and further action not inconsistent with this decision.

Should there be any questions about this decision please contact William R. Dixon, Jr., by letter addressed to Director, TC 1600, at the address listed above, or by telephone at 571-272-0519 or by facsimile sent to the general Office facsimile number, 571-273-8300.

Bruce M. Kisliuk.

Director, Technology Center 1600

